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STEVEN M. GREENBERG, ESQ.
CAREY, RODRIGUEZ, GREENBERG & PAUL LLP
950 PENINSULA CORPORATE CIRCLE
SUITE 3020
BOCA RATON FL 33487

Applicant: Thomas R. Firman
Application No.: 09/852,049
Filed: May 9, 2001
Title: VOICE CONTROLLED COMPUTER INTERFACE
Attorney's Docket No.: 1026-005U

:
: DECISION
: DISMISSING
: PETITION
:

This is a decision on the "PETITION UNDER 37 C.F.R. §1.183 TO PERMIT SUBMISSION OF A COMPUTER LISTING IN ADOBE PORTABLE DOCUMENT FORMAT," filed December 14, 2005 (the "petition"), seeking suspension of 37 CFR 1.96(c)(2) to submit a computer listing on compact disc in Adobe Portable Document Format (PDF) rather than in ASCII text format.

The petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 will be charged to Deposit Account No. 06-1050, as authorized in the transmittal letter that accompanied the petition.

For the reasons set forth herein, the petition is dismissed.

DISCUSSION

37 CFR 1.52(e)(3)(i) states:

Each compact disc must conform to the International Standards Organization (ISO) 9660 standard, and the contents of each compact disc must be in compliance with the American Standard Code for Information Interchange (ASCII). CD-R discs must be finalized so that they are closed to further writing to the CD-R.

37 CFR 1.96(c)(2) states:

The "computer program listing appendix" must be submitted on a compact disc that complies with § 1.52(e) and the following specifications (no other format shall be allowed):

- (i) Computer Compatibility: IBM PC/XT/AT, or compatibles, or Apple Macintosh;
- (ii) Operating System Compatibility: MS-DOS, MS-Windows, Unix, or Macintosh;

- (iii) Line Terminator: ASCII Carriage Return plus ASCII Line Feed;
- (iv) Control Codes: the data must not be dependent on control characters or codes which are not defined in the ASCII character set; and
- (v) Compression: uncompressed data.

37 CFR 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

The instant petition has been fully considered. 37 CFR 1.52(e) provides that computer program listings may be submitted to the Office on compact disc, the contents of which must be in ASCII format. Accordingly, petitioner seeks waiver of 37 CFR 1.52(e) as petitioner requests entry of a computer program listing on compact disc, the contents of which are in PDF format and not ASCII format.

The provisions of 37 CFR 1.52(e) may be waived under 37 CFR 1.183 where a petitioner demonstrates an extraordinary situation in which justice requires suspension of the rule. In support of his petition for waiver of the rule, petitioner notes that the computer program listing was originally submitted to the Office on microfiche in a parent application on June 23, 1989, and that petitioner is not in possession of an electronic version of the computer program.¹ Petitioner further notes, "Although in theory it would be possible to reconstruct an ASCII text file from a paper version of the microfiche, doing so would be unreasonably costly and, in any case, would inevitably include errors."²

As set forth in *Changes To Implement the Patent Business Goals*, 65 FR 54604, 54620 (Sept. 8, 2000) (final rule), any compact disc (CD-ROM or CD-R) containing a computer listing must meet the requirements of 37 CFR 1.52(e) or it will not be accepted by the Office. Specifically, the compact disc must meet the ISO 9660 format standards with ASCII data files as this is the only acceptable archival electronic media for submissions of computer listings on compact disc. If the Office were to waive the provisions of 37 CFR 1.52(e) as requested, the Office would need to perform the "reconstruction" identified in the petition.

Accuracy of the patent application's file should be paramount when determining who is better positioned to perform the reconstruction identified in the petition. Clearly, applicant has greater knowledge of the information contained in the computer listing, is better able to address issues that may arise during the construction of the ASCII text file, and is better able to ensure the accuracy of the computer listing after the ASCII text file is created. Therefore, applicant is

¹ See petition at page 1, paragraphs 1-3.

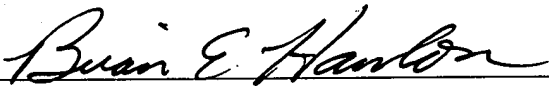
² See petition at page 1, paragraph 3.

better positioned to create the required electronic version of the computer listing in question that complies with 37 CFR 1.52(e).

For the reasons set forth above, petitioner has not presented facts that demonstrate an extraordinary situation in which justice requires suspension of 37 CFR 1.52(e), and the petition is dismissed.

CONCLUSION

The petition is dismissed for the reasons set forth herein, and the application is being forwarded to Technology Center 2600 for further processing. Telephone inquiries regarding this communication should be directed to Nicole Dretar at (571) 272-7717.



Brian Hanlon
Deputy Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy